

Atty. Docket No. JP9-2000-0267
(590.083)

REMARKS

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

The Office Action states that it is responsive to the application filed on September 27, 2001. As such, it is not clear whether or not the Examiner considered the Preliminary Amendment filed on February 28, 2002, which corrected a typographical error in the paragraph beginning on page 17, line 15. Clarification is respectfully requested.

Claims 1-22 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 4, 6, 10, 12-13, 15-17, 19-22 are independent claims; the remaining claims are dependent claims. All claims stand rejected 35 U.S.C. § 103(a) in view of Thielens et al. (hereafter "Thielens") in view of Stern et al. (hereafter "Stern"). Reconsideration and withdrawal of the present rejections are hereby respectfully requested.

The present invention broadly contemplates methods and systems for generally relates to a text data error correction support. (Page 1, Line 7) In accordance with the present invention, errors and incorrect conversions can be detected that tend to occur during the re-input of text that is written in a description language for which markups are used to describe data or sentences. (Page 8, Lines 2-4)

As best understood, Thielens appears to be directed to a copy editing apparatus and method. (Col. 1, lines 9-10) Copy editing as used in Thielens appears to refer to the process in which a manuscript copy is edited. As noted therein, such a process has traditionally been performed on paper, and certain conventions have emerged. See Col. 16, lines 33-36 ("These correspond to the aforementioned markings that the copy editor normally marks adjacent, for example, the chapter headings, to indicate how they will print. These markings are conventionally contained within a circle.") Such copy edit markings may be inserted into an electronic document through the use of a edit tags. See Col. 17, line 65 through Col. 18, line 20) There is no teaching or suggestion, however, that these copy edit markings are to be used for error correction.

As best understood, Stern appears to be directed to a system and method for the automatic preparation and searching of scanned documents, such as microfilm and paper, in which the probability of errors occurring during the preparation of the scanned documents is incorporated into the searching process. (Paragraph 1). Such approaches are typically referred to as "fuzzy searches". As stated in Stern, "[t]he advantage of the present invention is that is specifically ties the 'fuzziness' of the search to the amount of error which occurs during the OCR process." (Paragraph 48) Using a fuzzy search to compensate for the error occurring during the OCR process, Stern states that "the present invention is able to locate the word 'Henry' even when misspelled as 'Hehry'". (Paragraph 49) There is, however, no teaching or suggestion of error correction, as in the present invention.

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The instantly claimed invention requires specifically "defining a tag set to prevent errors or incorrect character conversions that occur frequently during the re-input of text". (Claim 1) Similar language appears in the other independent claims. Preventing errors or incorrect character conversions is simply not taught or suggested by either Thielens or Stern.

Moreover, combining the teachings of Thielens and Stern would not result in the instantly claimed invention. If these teachings were combined, fuzzy search logic would be incorporated into a manuscript copy editor such that it would be possible to search for terms which may be misspelled. Thus, following the teachings of Thielens and Stern would not result in the claimed invention of preventing errors or incorrect character conversions that occur frequently during the re-input of text. Thielens and Stern simply do not teach or disclose this, either alone or in combination.

While the outstanding rejection is based on the combination of Thielens and Stern, nearly twenty years ago, the Court of Appeals for the Federal Circuit recognized the importance of the individual references in characterizing the holding of *In re Imperato*, 179 USPQ 730 (C.C.P.A. 1973), as follows:

The lesson of this case appears to be that prior art referenced in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.

Again, in *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed. Cir. 1984), the Court stated:

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Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of reference can be combined **only** if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly, we hold the Court below erred as a matter of law in concluding the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

These Federal Circuit teachings are especially cogent here given the combination of Thielens and Stern fails to teach or suggest the instantly claimed invention.

In view of the foregoing, it is respectfully submitted that Claims 1, 4, 6, 8, 10, 12-13, 15-17, 19-22 are fully distinguishable over the applied art and are thus allowable. By virtue of dependence from Claims 1, 4, 6, 8, 10, 13, and 17, it is thus also submitted that Claims 2-3, 5, 7, 9, 11, 14 and 18 are also allowable at this juncture.

The "prior art made of record" has been reviewed. Applicant acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicant will be fully prepared to respond thereto.

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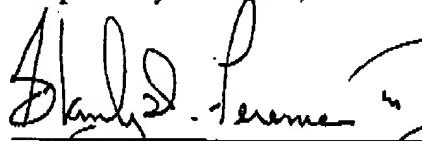
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In view of the foregoing, it is respectfully submitted that Claims 1-22 fully distinguish over the applied art and are thus in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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